

they choose. Issuing a restriction requirement within a claim, such as a particular occlusion agent, with the idea that Applicant would have to carve up that claim and pursue the nonelected subject matter in a separate application violates this right under section 112. Indeed, the C.C.P.A. has characterized such action as tantamount to a refusal to examine. See, In re Weber, 198 U.S.P.Q. 328 (C.C.P.A. 1978); In re Haas, 198 U.S.P.Q. 334 (C.C.P.A. 1978).

35 U.S.C. § 121 gives the Office authority to promulgate rules designed to restrict an application to one of several claimed inventions when those inventions are found to be independent and distinct. 35 U.S.C. § 121, however, does not give the Office authority to reject a particular claim on that basis. Weber at 332.

Finally, Applicant respectfully requests that all the claimed species continue to be examined in this application. If the Office chooses to maintain the election of species requirement, Applicant expects the Office, if the elected species are found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a reasonable number of the nonelected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Thus, in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office, the election of species requirement should be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP


1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 10, 2003

By: 
Carol L. Cole
Reg. No. 43,555

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com